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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC G. JAKSTADT, MICHAEL L. WATERSTON,
BADARI VASANTHA and JARROD E. PFOST

Appeal 2009-2335
Application 09/747,308
Technology Center 3600

Decided¹: April 14, 2009

Before MURRIEL E. CRAWFORD, DAVID B. WALKER, and KEVIN F.
TURNER *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants seek our review under 35 U.S.C. § 134 of the Final Rejections of claims 1-9, 19-25 and 27. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants' claimed invention relates to an electronic bill presentment and payment system comprising a user interface hosted by a financial service center which allows a registered user to navigate the financial service center and imperceptibly access detailed billing information from a biller hosted by a third-party. (Spec. p. 4, ll. 8-15). Claims 1, 4, 6, 9 and 19 reproduced below, are representative of the subject matter on appeal.

1. An electronic billing statement presented as a user interface (UI), the electronic billing statement comprising:

a first component hosted by a financial service center on a Web server, the first component to navigate the user interface (UI) and invoke one or more of the functions of the financial service center; and

a second component hosted by a third-party, the second component to provide detailed billing information from a biller to a user of the financial service center on the Web server.

4. An electronic billing statement according to claim 3, wherein the financial service center receives batch bill information along with authentication strings from the biller.

6. An electronic billing statement according to claim 1, wherein each of the financial service center and the third-party independently create the billing statement on the Web server.

9. A network facilitating electronic, bill payment and presentment to consumers, the network comprising:
a financial service center, providing a common network address where consumers can review and pay bills from a number of billers, to host at least a subset of a billing statement for review by a requesting user; and
a third-party server, coupled to the financial service center, to provide bill summary information to the financial service center, which securely and imperceptibly redirects the user to the third-party server which hosts at least a subset of the billing statement comprising detailed billing information.

19. An electronic bill presentment and payment (EBPP) system comprising:
one or more servers, coupled to a data network, through which billers and consumers access the EBPP system; and
a secure third-party development platform via which authorized third-party content developers can develop content for publication via the EBPP system for posting to users of the EBPP system on the one or more servers.

(Br. 17-19).

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hilt	6,408,284 B1	Jun. 18, 2002
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The Examiner rejected claims 1-9, 19-25 and 27 under 35 U.S.C. § 102(e) as being anticipated by Hilt.

Rather than repeat the complete details of the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

1) Have Appellants shown that the Examiner erred in establishing that Hilt discloses an electronic billing statement comprising both a first component hosted by a financial service center and a second component hosted by a third-party per claim 1?

2) Have Appellants shown that the Examiner erred in establishing that Hilt discloses each of the financial service center and the third-party independently create the electronic billing statement on the Web server per claim 6?

3) Have Appellants shown that the Examiner erred in establishing that Hilt discloses a financial service center providing a common network address where consumers can review and pay bills from a number of billers per claim 9?

4) Have Appellants shown that the Examiner erred in establishing that Hilt discloses a development platform to develop content for publication via an electronic bill presentment and payment system for posting to users of the system per claim 19?

5) Have Appellants shown that the Examiner erred in establishing that Hilt discloses the financial service center receives batch information along with authentication strings from the biller per claim 4?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Hilt is directed to a bill pay system wherein participating consumers pay bills to participating billers through a payment network. (col. 10, ll. 46-53).

2. Hilt discloses a connection of leased or dial-up lines between the data processing systems of the biller bank and data processing systems of the biller. (col. 19, ll. 8-14).

3. Dependent claim 4 recites “wherein the financial service center receives batch bill information along with authentication strings from the biller.” (Br. 17).

4. Hilt discloses receiving bill information, but does not explicitly disclose receiving batch billing information.

5. Hilt discloses that billers receive necessary A/R data from their banks in many different formats for different billers. (col. 17, ll. 42-55).

6. Hilt discloses most of the steps of the process are performed by software routines in computers, computer networks, and telecommunications equipment.” (col. 18, ll. 34-37).

7. Hilt discloses that any participating consumer can pay a bill through the payment network to any participating biller. (col. 20, ll. 50-67 and col. 21, ll. 1-4).

8. Hilt discloses that the biller bank may sponsor a biller direct connection to the payment network. (col. 19, ll. 15-21).

9. Appellants’ specification defines “development platform” as, “Development platform(s) 402(a-n) represent computing systems suitably endowed with content development software (e.g., Frontpage 2000 introduced above). According to one embodiment, each development platform 402(a-n) has a unique cert (not shown), which must be registered and have current authoring privileges in order to utilize the features of secure development system 116. (Spec pp. 17-18).

10. Hilt discloses that Bank C and Bank B include some means of data and message processing, and that a reference to a bank is not only to the organization but also to the computer systems maintained by those organizations or agents of those organizations which operate the bank component of the payment network. (col. 12, ll. 60-65).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

It is well established that while the features of an apparatus claim may be recited functionally, the apparatus must be distinguished from the prior art in terms of structure, rather than function. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Am. Acad. of Sci. Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

ANALYSIS

The Appellants argue claims 1, 4, 6, 9, and 19². We treat claim 1 as representative for claims 1-3, 7-8, 21-25 and 27, claim 4 as representative for claims 4 and 5, and claim 19 as representative for claims 19-22. *See* 37 C.F.R. § 41.37(c)(1)(vii).

² A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See*, 37 C.F.R. § 41.37(c)(vii).

ISSUE 1

Appellants argue that Hilt does not disclose an electronic billing statement comprising both a first component hosted by a financial service center and a second component hosted by a third party. According to Appellants, “Hilt only describes that a consumer receives an invoice from a biller, the consumer passes a bill pay order to the consumer’s bank, a payment message passes from the consumer’s bank to the biller’s bank, and the invoice is paid.” [citation omitted] (Br. 10). Further, Appellants argue that, “[s]ince Hilt does not show or disclose an electronic billing statement including first and second components hosted by separate entities, Hilt clearly can not show or disclose such a billing statement where the first component is hosted by a financial service center, and a second component is hosted by a third-party as recited in claim 1.” (Br. 10-11).

We are not persuaded by Appellants’ arguments and we agree with the Examiner’s findings that Hilt discloses an electric billing statement comprising a first component hosted by a financial service center and a second component hosted by a third-party (Ans. 6). It is well established that while the features of an apparatus claim may be recited functionally, the apparatus must be distinguished from the prior art in terms of structure, rather than function. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Hilt discloses that consumers pay bills to billers using a bill payment network (FF 1). Additionally, Hilt discloses that the step of paying a bill includes a connection between the data processing systems of the biller bank and data processing systems of the biller (FF 2). In performing these steps, Hilt discloses the requisite structure required by the claim: a first and second

component hosted by the data processing systems of the biller bank and data processing systems of the biller. Therefore, Appellants' argument is not persuasive as to error in the rejection.

ISSUE 2

Appellants argue that Hilt does not disclose that each of the financial service center and the third-party independently creates the electronic billing statement on the Web server. We are not persuaded by Appellants' arguments and we agree with the Examiner's findings that Hilt discloses wherein each of the financial service center and the third-party independently creates the electronic billing statement on the Web server. (Ans. 7). Hilt discloses that billers receive necessary account receivables data from their banks in many different formats (FF 5). The third party (payment network) independently generates the biller's billing statement and forwards the billing statement to the financial service center (bank), which then generates a billing statement to be viewed by the customer on the network. (FF 6). Therefore, both the financial service center and third-party independently create an electronic billing statement on the Web server. Accordingly, Appellants' argument is not persuasive as to error in the rejection

ISSUE 3

Appellants argue that Hilt does not disclose a financial service center providing a common network address where consumers can review and pay bills from a number of billers. In particular, Appellants argue that "[t]here is no indication in Hilt that a consumer can also review bills from a number of other billers at a single location." (Br. 13-14). Further, Appellants argue,

“Hilt also does not show or disclose any third-party server coupled to the financial service center, to provide bill summary information to the financial service center.” (Br. 14). We disagree with Appellants characterization of Hilt; we find that Hilt teaches that a participating consumer can pay a bill through the payment network to any participating biller. (FF 7). Thus, Hilt provides a common network wherein participating consumers can review and pay bills from a number of billers. Additionally, participants using the electronic bill pay system of Hilt can access the bill pay information from a third-party with a direct connection to the payment network. (FF 8). Therefore, Appellants’ argument is not persuasive as to error in the rejection.

ISSUE 4

Appellants argue that Hilt does not disclose a development platform to develop content for publication via an electronic bill presentment and payment system for posting to users of the system of claim 19. Claim 19 is directed to a secure third-party development platform. The claim further recites, via which authorized third-party content developers can develop content for publication. Accordingly, Appellants have chosen to define the development platform in terms of its function rather its specific structure.

A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In rejecting claim 19, the Examiner found that Hilt teaches a data and message processing means (FF 10). Appellants' specification broadly defines a development platform as computing systems suitably endowed with content development software (FF 9). We agree with the Examiner's findings that the data and message processing means of Hilt discloses the structure required by the claim. Further, since Appellants have not shown that Hilt does not possess the characteristics relied upon by the Examiner, we cannot say that a development platform which publishes content is not an inherent characteristic of the data and message processing means of Hilt. Accordingly, the Examiner's rejection is sustained.

ISSUE 5

Appellants argue that Hilt does not disclose the financial service center receives batch information along with authentication strings from the biller. More particularly, Appellants argue, "[t]he referenced section of Hilt simply describes a process of converting a non-participating biller into a participation biller, but does not discuss batch billing as recited in claim 4." [citation omitted] (Br. 12). The Examiner responds,

Hilt discloses a financial service center that receives batch bill information along with authentications strings from a biller (co1.19, lines 8-43) and authentication strings are sent to the third party to authorize delivery of the second component (co1.19, lines 8-43). The financial

service center receives the batch bill information along with authentication strings from the biller by way of the payment network. The claim does not specify that the financial service center receives the batch bill information along with authentication strings *directly* from the biller.

(Ans. 6-7).

While the Examiner is correct that Hilt discloses receiving billing information. (FF 4), Hilt does not indicate whether the billing information received is in the form of batch billing (FF 4), nor would this feature be found in Hilt under the principles of inherency. Therefore, we find the Examiner has erred in finding that Hilt discloses the financial service center receives batch information along with authentication strings from the biller.

Accordingly, we do not sustain the Examiner's rejections of claims 4 and 5 as rejected under 35 U.S.C. § 102(e) as being anticipated by Hilt.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 6-9, 19-25 and 27 as rejected under 35 U.S.C. § 102(e) as being anticipated by Hilt. Appellants have shown that the Examiner erred in rejecting claims 4 and 5 under 35 U.S.C. § 102(e) as being anticipated by Hilt.

DECISION

We AFFIRM the rejection of claims 1-3, 6-9, 19-25 and 27.

We REVERSE the rejection of claims 4 and 5.

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Application 09/747,308

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

MAT

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